



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681

23389 7590 04/21/2005

SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
SUITE 300  
GARDEN CITY, NY 11530

EXAMINER

PHAN, HUY Q

ART UNIT	PAPER NUMBER
2687	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

Huy Q Phan

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-18,20,21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) 1, 6, 7, 11-15, 23, 24, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,8-10,16-18,20,21 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II, Claims 3, 5, 8-10, 16-18, 20, 21 and 25 in the reply filed on 01/26/2005 is acknowledged.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 3, 5, 8-10, 16-18, 20, 21 and 25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 3 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Tiedemann, Jr. et al. (US-5,940,761).**

Regarding claim 3, Tiedemann, Jr. et al. disclose a method of facilitating handover (fig. 2 and its description) from an active network (original system S1) with which User Equipment (M1-M3) is in communication to another network (destination system S2), the method comprising the steps of:

receiving from User Equipment communicating via the active network an indication of at least one preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

in response thereto, providing to the User Equipment via the active network neighbor cell information for the at least one preferred other network (col. 5, lines 9-15, also see fig. 2 and its description).

Regarding claim 25, Tiedemann, Jr. et al. disclose a mobile communications network (fig. 2 and its description) or component thereof including:

means for receiving from User Equipment communicating with the network an indication of a preferred other network ("reports its finding"; col. 11, lines 36-43; also see col. 7, lines 45-59); and

means for supplying neighboring cell information for the preferred other network (col. 5, lines 9-15, also see fig. 2 and its description).

**5. Claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Den Heuvel. et al. (US-6,223,030).**

Regarding claim 16, Van Den Heuvel. et al. disclose a User Equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which User Equipment is in communication to another network (UMTS 14) (fig. 1 and col. 50-65; also see cols. 3-4) comprising: means for storing a list of available other networks supplied by the active network (fig. 6 and col. 5,

lines 18-24); means for transmitting from the User Equipment an indication of a preference for a network (fig. 1 and col. 50-65).

Regarding claim 17, Van Den Heuvel. et al. disclose the User Equipment according to claim 16, further comprising means for updating the stored list of available other networks based on information supplied by the active network (col. 3, lines 27-54 and fig. 1 and col. 50-65).

Regarding claim 18, Van Den Heuvel. et al. disclose a User Equipment (SU 20) for a mobile communications system capable of handover from an active network (communication system 19) with which the User Equipment is in communication to another network (UMTS 14) (fig. 1 and col. 50-65; also see cols. 3-4) comprising means for updating a stored list of available other networks based on information supplied by the active network (col. 3, lines 27-54 and fig. 1 and col. 50-65).

Regarding claim 20, Van Den Heuvel. et al. disclose the User Equipment according to claim 18, further comprising means for storing network preference information (col. 3, lines 55-64).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2687

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann, Jr. et al. in view of Chang et al. (US-6,272,315).**

Regarding claim 5, Tiedemann, Jr. et al. disclose the method according to claim 3. But, Tiedemann, Jr. et al. do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang et al. teach a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tiedemann, Jr. et al. as taught by Chang et al. for purpose of providing the user with the most needed information of the available networks in order to increase significantly the efficiency of wireless communication service.

**8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel. et al. (US-6,223,030) in view of Chang et al. (US-6,272,315).**

Regarding claim 8, Van Den Heuvel. et al. disclose a method (fig. 1 and col. 50-65) of operating the User Equipment capable of handover between an active network (communication system 19) and another network (UMTS 14) comprising a stored list of available networks based on information supplied by the active network with which the User Equipment is in communication (col. 2, lines 54-55 and also see cols. 3-4).

But, Van Den Heuvel. et al. do not particularly show a step of incrementally adding to or subtracting from the list of available networks. However in analogous art, Chang et al. teach a step of incrementally adding to or subtracting from the list of available networks (col. 7, lines 16-22); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel. et al. as taught by Chang et al. for purpose of offering the user with the most needed information of the available networks in order to provide the most efficient wireless communication service.

Regarding claim 9, Van Den Heuvel. et al. and Chang et al. disclose method of claim 8. Van Den Heuvel. et al. further disclose a step of signaling to the active network (communication system 19) with which the User Equipment is in communication a preferred other network (UMTS 14) for handover (col. 1, lines 50-65 and also see cols. 3-4).

Regarding claim 10, Van Den Heuvel. et al. and Chang et al. disclose method of claim 9. Van Den Heuvel. et al. further disclose wherein said preferred other network is selected by the User Equipment from a list of available networks supplied by the network (col. 1, lines 50-65).

**9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Heuvel. et al. in view of Gourgue et al. (US-6,584,116).**

Regarding claim 8, Van Den Heuvel. et al. disclose the User Equipment according to claim 16.

But, Van Den Heuvel. et al. do not particularly show wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks. However in analogous art, Gourgue et al. teach wherein the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks (col. 2, lines 15-45); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Van Den Heuvel. et al. as taught by Gourgue et al. for purpose of allowing the user equipment with capability continuously communicating while moving from UMTS network to GSM network.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

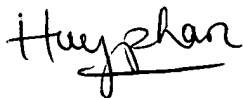


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid G Lester can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**SONNY TRIPP**  
**PRIMARY EXAMINER**

Examiner: Phan, Huy Q.

AU: 2687

Date: Apr. 16, 2005